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SUPREME COURT, U.S.

IN THE
Supreme Court of the United States

OREN TAVORY,

Petitioner,

v.

NTP, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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COUNTER STATEMENT OF QUESTIONS PRESENTED

1. Whether the Federal Circuit's nonprecedential opinion in this case properly applied well-settled principles of patent law in affirming the district court's denial of Tavory's belated claim of joint inventorship when Tavory failed to adduce sufficient corroborated evidence that he either participated in, or made a substantial contribution to, the conception of the wireless email systems described and claimed in the Campana Patents.

2. Whether, in these circumstances, this Court should consider creating a new equitable royalty sharing remedy for co-inventors under federal common law when that remedy would directly conflict with Congress's contrary policy judgment, embodied in 35 U.S.C. § 262, that each co-owner may independently license the invention.

**RULE 29.6 CORPORATE DISCLOSURE
STATEMENT**

NTP is a closely held corporation. There is no parent or publicly held corporation owning 10% or more of NTP's stock.

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JURISDICTION

NTP believes that this Court has jurisdiction on the ground recited in Tavory's petition. Pet. 2.

INTRODUCTION AND SUMMARY OF REASONS TO DENY THE PETITION

Petitioner seeks review of a nonprecedential decision by the Court of Appeals for the Federal Circuit affirming the district court's rejection of his belated claim of joint inventorship in Respondent's patents. Both the district court and the Federal Circuit correctly applied the well-settled legal requirements for adjudicating a joint inventorship claim. In particular, the putative unnamed co-inventor must prove, by clear and convincing evidence, that he participated in, and made a significant contribution to, the "conception" of the invention claimed in the patents-at-issue.

In this case, the invention at issue is the integrated wireless electronic mail systems, including specific architectures, configurations and interactions of multiple system components, set forth in the claims of the Campana Patents. The factual record is undisputed that this invention was jointly conceived by the named inventors (Campana, Ponschke and Thelen) in Chicago. There is no evidence, corroborated or otherwise, that Tavory, who was employed as a computer programmer in Florida, ever participated in the conception of the pioneering Campana wireless email systems technology.

Instead, Tavory claims – sixteen years after the fact – that he conceived an entirely different idea, *i.e.*,

“sending emails to pagers,” before the named inventors made their invention. As the courts below found, however, the alleged invention of sending “emails to pagers” is technologically distinct from the patented Campana systems technology and Tavory failed to present any evidence that his alleged pager “invention” was either novel, nonobvious, sufficiently corroborated by a contemporaneous enabling disclosure, or made available to the Campana inventors before their conception.

In rejecting Tavory’s joint inventorship claim, the courts below broke no new legal ground. They correctly stated established legal standards and properly applied those standards to a technologically complex summary judgment record. The Federal Circuit’s nonprecedential decision presents no unsettled issue of patent law that warrants review by this Court.

Likewise, Tavory’s request for creation of a new federal “equitable” cause of action is contingent upon his joint inventorship claim, and therefore purely hypothetical and unripe. On grounds of both standing and ripeness, the Court should decline Tavory’s invitation to issue an advisory opinion on abstract issues of federal common law divorced from a concrete factual record. Moreover, as discussed in the opinions below, Tavory’s proposed licensing fees “disgorgement” remedy would directly conflict with Congress’s policy judgment embodied in 35 U.S.C. § 262 providing broad latitude for co-owners/inventors to enjoy the fruits of their inventions free from claims for equitable monetary relief.

STATEMENT OF THE CASE

A. Factual Background

1. Invention of the Campana Patents

The “Campana Patents” in which Tavory claims co-inventorship¹ describe and claim a pioneering wireless electronic mail system, now embodied in the popular BlackBerry® service, that allows out-of-office users to continue to receive and send email on a mobile computer. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005), *cert denied*, 546 U.S. 1157 (2006) (the “NTP/RIM” case). The Campana invention consists of multiple system components specially configured to integrate existing electronic mail systems with radio frequency (“RF”) wireless communications networks.² The Campana Patents include a variety of individual system components (*e.g.*, email servers, RF receivers, mobile processors), some of which were well known in the prior art. The Campana inventors conceived and reduced to practice the overall system architectures and configurations of elements to create

¹ U.S. Patent Nos. 5,436,960; 5,438,611; 5,625,670; 5,631,946; 5,819,172; 6,067,451, 5,479,472, and 6,317,592 (collectively the “Campana Patents”).

² The Federal Circuit’s *NTP/RIM* opinion describes the components and operation of the Campana invention. 418 F.3d at 1289. The various components of the patented systems can include, *inter alia*, desktop computers, email servers, distributed intelligence enhancements, gateway/interface components, RF networks, RF receivers, and mobile destination processors. *See id.* at 1294-1311.

the innovative wireless email technology as set forth in the specific claims of the Campana Patents.

The inventions resulting in the "Campana Patents" were conceived by Thomas J. Campana, Michael P. Ponschke and Gary F. Thelen, all of whom worked in Chicago at ESA, a small engineering consulting firm.³ ESA had a close working relationship with Telefind, a telecommunications start-up based in Florida that operated a nationwide paging network (A.3). Campana and his ESA co-workers used the Telefind RF network to reduce their invention to practice "before November 1990 when Campana demonstrated it at a large trade show to much acclaim" (A.4).

ESA and Telefind also worked with AT&T in late 1990 and early 1991 to develop a commercial product based on Campana's wireless email technology (the "AT&T laptop project").⁴ Tavory was involved as one of several Telefind programmers working on that project, along with Ponschke and Thelen, two programmers at ESA. Telefind ran out of funds in 1991 and began to collapse. As a result, the laptop project was never brought to market. (A.4).

³ The most detailed, concise description of Campana's conception and reduction to practice is found in his PTO declaration and his extensive contemporaneous supporting documentation, which appear in the joint appendix below at A492-A516 and A519-A659, respectively.

⁴ "The objective of that project was to create the first commercially viable, wireless-enabled laptop computer." (A.26-27).

2. The *NTP/RIM* Litigation and Tavory's 2002 Deposition

In November 2001, NTP filed suit against Research In Motion, Ltd. ("RIM") in the U.S. District Court for the Eastern District of Virginia, accusing RIM's BlackBerry® systems of infringing the Campana Patents. Tavory was contacted by RIM and NTP in January 2002 and was deposed by RIM in September 2002. Tavory was extensively questioned regarding his work at Telefind in 1990, the Campana Patents and the software code that Tavory helped to write for the AT&T laptop project. Tavory never made any claim of inventorship at his deposition and emphatically disavowed (over 100 times) knowledge concerning the conception and reduction to practice of the Campana inventions. (See A.22-23; A.35-36).

The *NTP/RIM* case proceeded to trial before Chief Judge Spencer in November 2002. At trial, Mr. Campana testified at length about the conception and reduction to practice of the Campana Patents and supported his testimony with undisputed corroborating documentation. NTP won a jury verdict awarding more than \$23 million, obtained a judgment of more than \$50 million in damages, and the district court awarded a permanent injunction, which it stayed pending appeal. After an unsuccessful appeal to the Federal Circuit, and denial of *certiorari* by this Court, RIM elected to settle the litigation, agreed in early 2006 to take a license to resolve all past and future infringement, and paid NTP \$612.5 million. (A.4-5).

3. Tavory's Attempts To Extort Money from NTP and To Fabricate Corroborating Documentation

Campana died in June of 2004. After his death, and after announcement of the \$612.5 million settlement with RIM, Tavory contacted NTP and demanded a share of the settlement. In direct contradiction of his 2002 deposition testimony, Tavory now asserted that he had created Campana's wireless email technology long before Campana and that he had demonstrated the technology to his Telefind co-workers prior to Campana's conception date.

Because Tavory's invention story had never surfaced during the aggressively litigated *NTP/RIM* case, NTP requested supporting contemporaneous documentation, which Tavory refused to provide. Instead, Tavory indicated that his corroboration would be in the form of oral testimony from his Telefind co-workers describing their sixteen-year-old recollections. Tavory also threatened a copyright lawsuit based on allegations that Tavory owned the software in the Campana Patent appendix and that NTP committed copyright infringement every time its attorneys made copies of the Campana Patents during litigation.

At some point, Tavory recognized that his lack of documentation would be fatal to his attempts to extract money from NTP. Tavory then fabricated his own supporting document. Tavory used the November 25, 1990 software listing (found in the original Campana patent application) to "reconstruct" a purported earlier version of the same software. (See A.30-34). Tavory made

numerous deliberate alterations. He removed the November 25, 1990 date so that he could argue that he created the software earlier in 1990 in order to pre-date the named inventors' conception. In addition, Tavory removed the name of his employer, Telefind, from the fabricated software listing in an attempt to assert that he, rather than Telefind, owned the software.

In July 2006, Tavory filed this newly "reconstructed" software in an application to the Copyright Office and falsely asserted its date of creation to be 1990. The Copyright Office, relying on Tavory's misrepresentation, issued a copyright registration.

B. Proceedings Below

1. Tavory's Complaint and Subsequent False Discovery Answers

In September 2006, Tavory sued NTP for correction of inventorship, copyright infringement, and unjust enrichment under state law. The case was assigned to Judge Spencer, who had presided over the *NTP/RIM* litigation and trial. Tavory's complaint alleged that he had invented "the concept of sending emails to pagers" and that he was entitled to compensation for NTP's use of the "Tavory invention" and his copyrighted software (A.108). Tavory appended his fabricated "reconstructed" software as Exhibit A to his complaint and cited the document in support of both his inventorship and copyright counts.

Because of its suspicious appearance and content, NTP repeatedly probed the provenance of Exhibit A

during discovery. Tavory provided false discovery answers stating, in substance, that the newly-fabricated software listing had been in existence at the time of the May 21, 1991 Campana patent application filing. *See Tavory v. NTP, Inc.*, No. 3:06-CV-628, 2007 U.S. Dist. Lexis 75062, at *4-*8 (E.D. Va. Oct. 9, 2007), *aff'd*, 297 F. App'x 986 (Fed. Cir. 2008). This was a false statement. Not until his deposition at the end of the case did Tavory finally reveal that he had “reconstructed” this software listing in 2006 and that it had not existed in 1990-91.

2. The District Court's Summary Judgment Dismissing Tavory's Copyright Claims and Award of NTP's Attorneys Fees

After discovery closed, the district court granted summary judgment to NTP dismissing Tavory's copyright count on a number of grounds, including Tavory's submission of a fraudulent application to the Copyright Office to obtain his registration (A.30-41). The district court awarded NTP a portion of its attorneys fees attributable to the copyright count. *Tavory*, 2007 U.S. Dist. Lexis 75062, at *4-*8.

Tavory did not appeal the dismissal of his copyright claims, but did appeal the award of attorneys fees. The Federal Circuit affirmed the fee award on October 28, 2008, and this Court denied *certiorari* on March 30, 2009 (Dkt. No. 08-952).

3. The District Court's Summary Judgment Dismissing Tavory's Inventorship Claims

The district court also granted summary judgment rejecting Tavory's claim to be recognized as a co-inventor of the Campana Patents (A.41-44). The court applied well established precedent regarding: (1) the "strong presumption that those named in an issued patent are the true and correct inventors;" (2) the substantive requirement that an alleged joint inventor must make a substantial contribution "to the conception of the claimed invention;" and (3) the evidentiary requirement that "conception and corroboration must be proven by clear and convincing evidence" (A.41-42).

The district court explicitly noted that Tavory's alleged invention, which Tavory described as "the concept of sending emails to pagers" (A.108), was "technologically distinct from the wireless email *systems* that Mr. Campana and his associates patented" (A.43, emphasis added). Although there was evidence that Tavory was among a pool of Telefind programmers who worked on the AT&T laptop project, those programmers wrote code for the proposed commercial product after Campana and his ESA co-workers had conceived and reduced to practice their wireless email system invention. With respect to the inventions actually described and claimed in the Campana Patents, there was simply no evidence, corroborated or otherwise, that Tavory actually interacted with the named inventors, all of whom worked in Chicago, during their conception of the wireless email systems (A.43-44).

4. The District Court's Dismissal of Tavory's Unjust Enrichment Claims

In a separate opinion (A.49-55), the district court dismissed Tavory's state-law unjust enrichment count for failure to state a claim. Fed. R. Civ. P. 12(b)(6). Tavory had based this count on NTP's alleged use of his copyrighted software and the so-called "Tavory invention" (*i.e.*, defined in the complaint as "sending emails to pagers").

The district court found that Tavory's unjust enrichment claims were preempted by both federal copyright and federal patent law. With respect to federal copyright preemption, the court determined that Tavory's state-law claims regarding use of his software were preempted because (1) the work at issue was squarely within the subject matter of copyright and (2) the rights granted under state law are equivalent to the exclusive rights set forth within the scope of federal copyright law. *U.S. ex rel. Berge v. Bd. of Trustees*, 104 F.3d 1453 (4th Cir. 1997) (A.51-52).

With respect to Tavory's unjust enrichment claims based on his status as putative co-inventor, the district court dismissed those claims under the doctrine of conflict preemption under federal patent law. Even if Tavory were recognized as an inventor, Section 262 of the Patent Code expressly provides that "[i]n the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention . . . without the consent of and without accounting to the other owners." 35 U.S.C. § 262. Because Tavory was attempting to use his

derivative unjust enrichment claim to seek an accounting expressly proscribed by Section 262, "state law is displaced." (A.52-54).

Subsequently, Tavory moved to amend his complaint to add a vague cause of action for unspecified "federal equitable relief." (A.56). The district court denied Tavory's motion to amend on grounds that the amendment would be futile since Tavory's repackaged federal version of his state-law unjust enrichment claims could not withstand a Rule 12(b)(6) motion to dismiss. "A demand for equitable relief in conflict with the scheme that Congress has established is therefore impossible, regardless of whether the claim sounds in state or federal law." (A.45-48).

5. The Federal Circuit's Unanimous, Nonprecedential Affirmance of the District Court's Rulings

On October 27, 2008, the Federal Circuit issued an unpublished, nonprecedential opinion affirming Judge Spencer's rulings rejecting Tavory's inventorship claim, his state law unjust enrichment claim and his attempt to add a new vague claim for unspecified "federal equitable relief." (A.1-24). The majority opinion affirmed summary judgment on the inventorship claim because Tavory failed to raise a genuine issue of material fact as to his alleged contribution to the conception of the *wireless email systems* actually claimed in the Campana Patents. (A.6-13). It affirmed dismissal of Tavory's unjust enrichment claim because that claim was preempted by 35 U.S.C. § 262. (A.14-19). Finally, it affirmed the district court's denial of leave to amend because the

district court did not abuse its discretion in holding that Tavory's vague "federal equitable relief" claim was duplicative of his already-pled claims and therefore futile. (A.20-22).

Judge Newman issued a concurring opinion agreeing that all of Tavory's claims should be dismissed. (A.22-24). Judge Newman, however, would not have reached the merits of the joint inventorship issue, or the contingent claims for unjust enrichment and "federal equitable relief." Instead, she would have dismissed on either of two alternative grounds, *i.e.*, laches and/or estoppel by silence. "Whether or not Mr. Tavory should have been or could have been named as a joint inventor, he waited too long to make the claim" (A.24).

REASONS FOR DENYING THE PETITION

I. Tavory's Petition Wholly Fails To Meet The Standards Of Rule 10.

Under Rule 10, this Court will exercise its discretion to review a decision of a United States Court of Appeals by writ of *certiorari* "only for compelling reasons." Here, there is no conflict among the circuits, no conflict with a decision by a state court of last resort, and no claim that the courts below have "so far departed from the accepted and usual course of judicial proceedings" to warrant exercise of this Court's supervisory power. Sup. Ct. R. 10(a). Nor does Tavory identify any "important question of federal law" decided by the court below that either conflicts with this Court's decisions or is so pressing and unsettled that it should now be resolved by this Court. Sup. Ct. R. 10(c). At most,

Tavory contends that the Federal Circuit misapplied well-established legal standards regarding joint inventorship, a type of alleged error that “rarely” justifies review on *certiorari*. Sup. Ct. R. 10.

As discussed in more detail below (*infra*, pp. 12 - 16), the Federal Circuit’s nonprecedential decision broke no new legal ground with respect to the standards for establishing joint inventorship. The decision correctly states that Tavory must prove, by clear and convincing evidence, that he made a substantial contribution to the “conception of the *claimed invention*” (A.7, emphasis added). The “claimed invention” in this case is defined by the claims of the Campana Patents and comprises the overall system architectures, configurations of components and prescribed interactions of those components that constitute Campana’s pioneering wireless email technology.

The district court correctly found, and the Federal Circuit affirmed, that Tavory produced no evidence that he participated with the named inventors, Campana, Ponschke and Thelen, in their conception of wireless email system. Indeed, in his complaint, Tavory alleged that his so-called “Tavory invention” was something entirely different, *i.e.*, “the concept of sending emails to pagers” (A.108 at ¶ 43). Contrary to Tavory’s petition and briefs below, the alleged invention of “sending email to pagers” is not the same thing as the “interface switch” element in the claims of the Campana Patents. In particular, under the district court’s undisputed claim construction, the “interface switch” element of the claimed wireless email systems must transmit “electronic mail messages to a wireless system for delivery to a *mobile processor*.” (A.8, emphasis added).

Tavory's attempt to create an entirely new equitable remedy under the Patent Act and federal common law (see Questions Presented No. 2) depends on recognition of his joint inventorship claim and is therefore purely hypothetical and unripe. Unless and until Tavory can prove at trial, by clear and convincing evidence, that he actually participated in, and made a substantial contribution to, the conception of the Campana wireless email technology, the question of possible "federal equitable remedies" is advisory and without a concrete factual context.

Moreover, any consideration of a new federal "equitable" cause of action would necessarily require consideration of the alternative grounds for affirmance discussed in Judge Newman's concurring opinion. (A.22-24). Tavory's claims, whether for inventorship or "equitable" disgorgement of RIM licensing payments, are barred on grounds of laches and estoppel by silence and unclean hands. Tavory was well aware of the *NTP/RIM* litigation in 2002 and was deposed at length regarding his software code and his role, if any, in the conception and reduction to practice of the Campana Patents. He was under "a clear duty to speak," yet never mentioned the possibility of his alleged joint inventorship claim. (A.22-23; see A.36 ("in 2002, Tavory testified that he could not remember whether he wrote the Push Software at Mr. Campana's direction, or to what extent he was involved in the authorship of the source code")). Similarly, over the next four years, throughout the trial, appeals and ultimate settlement of the highly publicized *NTP/RIM* litigation, Tavory sat mute. Instead, he waited until "after Mr. Campana had passed away, and after a healthy settlement between

NTP and Research In Motion had been reached" before he suddenly came forward with a fabricated "reconstruction" of his alleged software and belated – by sixteen years – claim of inventorship. (A.23 & A.35 n. 4).

As the courts below observed, even assuming Tavory's claims were legally competent, "*equity would compel dismissal with all due haste.*" (A.36-37 (emphasis added); A.35 ("[Tavory's] delay in asserting his authorship has been excessive and unreasonable, and no satisfactory explanation has been offered")). "Whether or not Mr. Tavory should have been or could have been named as a joint inventor, he waited too long to make the claim. That is a sufficient ground of affirmance." (A.24, Newman, J.).

II. The Federal Circuit's Nonprecedential Opinion Correctly States And Applies Well-Settled Legal Standards in Rejecting Tavory's Joint Inventorship Claim.

Both the district court and the Federal Circuit correctly articulated the exacting burden imposed on those seeking to establish a *post hoc* claim of co-inventorship to an issued U.S. patent. The key legal standards include:

1. There is a strong presumption that those named on an issued patent are the true and correct inventors, and a putative unnamed co-inventor must prove his inventorship by clear and convincing evidence. *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997). (A.6-7 & A.41).

2. The “touchstone” of inventorship is *conception*, which is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention. *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). (A.7 & A.41).
3. A co-inventor must prove that he made a significant “contribution to the conception of the claimed invention.” *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998). (A.7 & A.42, emphasis added).
4. This contribution must be more than the exercise of ordinary skill in the art, and simply reducing to practice an invention that was conceived by others is insufficient for co-inventorship. *Ethicon*, 135 F.3d at 1460. (A.7 & A.42).
5. A putative co-inventor’s own statements are inadequate to prove conception as a matter of law and must be corroborated by independent evidence of a contemporaneous disclosure that would enable one skilled in the art to make the claimed invention. *Ethicon*, 135 F.3d at 1461; *Burroughs*, 40 F.3d at 1228. (A.7-8 & A.42).

Tavory’s petition does not challenge the legal standards for joint inventorship set forth in the opinions below

(see, e.g., Pet. 15-16). Indeed, quoting from *Ethicon*, Tavory concedes that the “critical question for joint conception is who conceived, as that term is used in the patent law, *the subject matter of the claims at issue*” (Pet. 15, emphasis added).

In this case, the “subject matter of the claims at issue” is entire integrated wireless electronic mail systems, including specific architectures, configurations and interactions of multiple system components, as set forth in the claims of the Campana Patents. The factual record is undisputed that this invention was jointly conceived by the named inventors, Campana, Ponschke and Thelen, while working at ESA in Chicago. There is simply no evidence, let alone clear, convincing and corroborated evidence, that Tavory ever participated in any way with the named inventors in their conception of the wireless email systems technology.

Indeed, Tavory makes no such claim. To the contrary, his complaint alleges that he independently invented something entirely different, *i.e.*, “*the concept of sending emails to pagers*” (A.108 at ¶ 43, emphasis added), long before Campana and his co-workers conceived of their invention of an integrated wireless electronic mail system. Likewise, all of Tavory’s purported corroborating witnesses only discuss the so-called “idea of sending emails to pagers” (see Pet. 21-24), and not one of the eleven witnesses ever suggested that Tavory actually participated with Campana, Ponschke and Thelen in their conception of “the subject matter of the claims at issue,” *i.e.*, the integrated wireless email systems.

As the district court correctly found, Tavory's alleged "idea of sending emails to pagers" (see Pet. 21) was "technologically distinct from the *wireless email systems* that Mr. Campana and his associates patented." (A.43, emphasis added). For this reason, "there is no credible evidence that can be offered establishing that Tavory participated in the *conception* of the wireless email systems." (A.44, emphasis added). The Federal Circuit affirmed the district court's analysis, noting that all of the testimony and witnesses offered by Tavory "do not bear on *conception* and do not indicate Tavory ever made a contemporaneous enabling disclosure" to Campana or anyone else. (A.12, emphasis in original). The complete lack of any evidence that Tavory ever participated with the named inventors in their conception of the patented wireless email systems technology is fatal to Tavory's joint inventorship claim.

The Federal Circuit also analyzed Tavory's related appellate argument that he allegedly conceived of the "interface switch," which is a claim element in multiple claims of the Campana Patents. The Court of Appeals rejected this argument on two separate grounds. First, it found that Tavory had failed to adduce any evidence that his alleged conception of "sending emails to pagers" was novel and nonobvious, as opposed to arising from the exercise of ordinary skill in the art. The subject matter of the claims of the Campana Patents, by contrast, comprises wireless electronic email systems that include a number of elements from the prior art (*e.g.*, email servers, RF receivers). Thus, even assuming that Tavory could show that he actually participated in the conception of the Campana wireless email systems, there was no corroborated evidence that "his alleged

contribution to the claimed invention – the interface switch – was the result of anything more than the exercise of ordinary skill in the art [and therefore] he has failed to establish co-inventorship” (A.8-10).⁵

Second, the Federal Circuit also found, as an independent ground for affirmance, “that Tavory failed to provide sufficient corroborating evidence that he *conceived* of the interface switch” (A.10, emphasis in original). At most, the evidence showed that Tavory wrote software code dated November 25, 1990 as part of the AT&T laptop commercialization effort, but this was well after the named inventors had already demonstrated the working invention at a national trade show. Moreover, even if Tavory had assisted in reducing to practice the interface switch for the wireless email systems claimed in the Campana Patents, such activity alone is “irrelevant” to the issue of conception (A.12-13). As the Federal Circuit noted, “components of an invention may themselves be entirely in the prior art so reducing such a component to practice is not evidence of any inventive conception.” (A.12). By the same token, “inventors are not required to have known how to

⁵ Contrary to Tavory's assertion (Pet. ii & 10), the Federal Circuit did not require “proof that the co-inventor's contribution is not in the prior art.” Rather, consistent with well-settled precedent, the Federal Circuit held that Tavory could not establish a significant contribution to the patented Campana technology based solely on his alleged independent reduction to practice of a single component of the claimed wireless email systems. “[C]omponents of an invention may themselves be entirely in the prior art so reducing such a component to practice is not evidence of any inventive conception.” (A.12).

reduce their conceived invention to practice to establish conception" (A.13).⁶ Consequently, Tavory's participation in writing code for the commercial AT&T laptop product is simply irrelevant to "conception" and provides no basis for his inventorship claim.

In sum, the courts below correctly stated the well-established legal standards governing joint inventorship and properly applied those standards to a technologically complex summary judgment record. Fortunately, both the district court and the Federal Circuit were intimately familiar with the patented Campana technology from the previous *NTP/RIM* litigation. Both courts correctly found that Tavory had failed to adduce any corroborated evidence that he had participated with the named inventors in conception of the Campana wireless email systems, or that he made any contemporaneous enabling disclosure to the named inventors that would establish co-inventorship.

⁶ Tavory's petition mischaracterizes the Federal Circuit's opinion as holding "that to prove his conception was sufficiently fixed and permanent by evidence of reduction to practice, [Tavory] had to prove reduction to practice of the *entire* invention" (Pet. 11). The Federal Circuit did no such thing. Instead, it correctly distinguished cases such as *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998), which did involve "reduction to practice of the *entire* invention," from Tavory's claim that he independently reduced to practice only a single component of the Campana wireless email systems, without any showing that his efforts were novel, nonobvious or anything other than the exercise of ordinary skill. (A.12).

III. The Federal Circuit Properly Rejected Tavory's Dependent Unjust Enrichment Claims As Inconsistent With The Purposes And Objectives Of Section 262 Of The Patent Code.

Tavory would have standing to seek equitable remedies, whether for state law unjust enrichment (Pet. 26-31) or for the creation of an entirely new form of unspecified "federal equitable remedy" (Pet. 31-36) only if he were a co-inventor. Because Tavory cannot establish by clear and convincing evidence that he is a co-inventor of the Campana Patents, the issue whether equitable remedies might be available to a so-called "displaced co-inventor" is purely advisory and premature. This Court lacks jurisdiction to adjudicate a contingent claim as to which petitioner lacks standing. *See Warth v. Seldin*, 422 U.S. 490, 498-99 & n.10 (1975) (federal court jurisdiction is limited by both standing and ripeness).

In any event, the Federal Circuit correctly held that Tavory's unjust enrichment claims directly conflict with 35 U.S.C. § 262 and are therefore preempted by federal patent law. (A.14 19). The legislative history of Section 262 reveals that Congress considered, but *expressly rejected*, Tavory's position that joint inventors/owners needed to provide accounting to each other. The initial proposal to the House Judiciary Committee included an "accounting" provision:

§ 65. Joint owners

Whenever two or more persons own a patent jointly, either by the issuing of the patent to

them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use or sell the patented invention for his own benefit without accounting to the other joint owners, subject to any contract or agreement, but *neither of the owners may grant licenses or assign his interest, or any part thereof without the consent of the other owners, or without proportionately accounting to the other joint owners.*

Note

The first part of this section states existing law but the last clause *effects a change in the law in requiring consent or an accounting between joint owners in the case of an assignment or license.*

Staff of H. Comm. on the Judiciary 81st Cong., Proposed Revision and Amendment of the Patent Laws (Comm. Print 1950) (emphasis added). Notably, the adopted version of Section 262 expressly rejected such an accounting.

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the

United States, *without the consent of and without accounting to the other owners.*

35 U.S.C. § 262 (emphasis added). Thus, Congress made a policy judgment, based on “existing law,” that there should not be an accounting between owners “in the absence of any agreement to the contrary.” Instead, Congress explicitly imposed a direct foreclosure of co-inventor claims for equitable monetary relief.

The congressional policy embodied in Section 262 plainly applies to licensing of patent rights. *Univ. of Colo. Found., Inc. v. Am. Cyanamid Co.*, 196 F.3d 1366, 1373 (Fed. Cir. 1999) (“*Cyanamid IV*”). Thus, even accepting Tavory’s unsubstantiated contention that he is a co-owner of the Campana Patents, Section 262 would still bar his claim to any portion of the licensing fees received by NTP from various licensees, including RIM. For this reason:

Tavory cannot sidestep § 262 through a state law unjust enrichment claim; such a claim is preempted because it “stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress” in enacting § 262, as the district court correctly held.

(A.16).⁷

⁷ The Federal Circuit’s unpublished opinion also addressed and correctly rejected the additional arguments advanced in Tavory’s petition regarding Section 262. See, e.g., A.16-18 (Cont’d)

For the same reason, there is no basis for the judicial creation, under the guise of federal common law, of an entirely new disgorgement or other equitable monetary remedy for putative co-inventors. Congress's policy judgment in enacting Section 262 is clear: each co-owner of a patent is free to pursue independent exploitation of the patent rights and is broadly protected against any form of accounting, except by "agreement," to other co-owners. As the Federal Circuit recognized, this same Section 262 analysis applies with equal force to Tavory's "purported federal version of his state law unjust enrichment claim," and any amendment to add such a claim would be futile. (A.20-22).⁸

Finally, Tavory's appeal to "policy interests" (Pet. 35-36) in support of the creation of entirely new federal equitable remedies for putative co-inventors is equally unavailing. If anything, the factual circumstances in this case demonstrate that such an

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(discussing Tavory's arguments based on *Cyanamid IV* and *Ultra-Precision Manufacturing Ltd., v. Ford Motor Co.*, 411 F.3d 1369 (Fed. Cir. 2005)); A.18-19 (addressing Tavory's strained distinction between "co-owners" and "co-inventors").

⁸ Tavory's argument that federal common law already provides an equitable monetary remedy for displaced co-inventors (Pet. 31) is baseless, as is his assertion (*id.*) that the Federal Circuit "disregarded" *Arachnid, Inc. v. Merit Industries, Inc.*, 939 F.2d 1574 (Fed. Cir. 1991). The Federal Circuit's opinion specifically discusses *Arachnid* in some detail, concluding that the case "is inapposite here" and "certainly does not support a vague cause of action for unspecified 'federal equitable relief.'" (A.21-22).

advisory ruling would be contrary to the public interest by opening the floodgates to spurious, follow-on litigation based on suspect claims, asserted years after the fact, of alleged joint inventorship. Under Tavory's theory, an individual who believed, rightly or wrongly, that he should have been named as a co-inventor on a patent would have no incentive to make his claim promptly. Instead, he could simply sit back and wait until the patent was tested in litigation and proved to be commercially valuable. Then, long after the fact and when many of the key witnesses might be dead or unavailable, the putative co-inventor would suddenly emerge and demand a share of the monetary proceeds under a federal common law "disgorgement" theory.

Multi-million dollar judgments and/or settlements in major patent cases are announced almost on a daily basis. In each instance, various individuals who had some tenuous connection to the underlying technology could, under Tavory's proposed federal equitable remedies, threaten suit and attempt to extort money from the legitimate owners of the patent based on fabricated documentation and/or uncorroborated, decades old recollections of their friends. Such a result would contradict the judgment made by Congress in 35 U.S.C. § 262 and spawn a myriad of dubious follow-on lawsuits.

CONCLUSION

For all of the reasons above, NTP respectfully submits that the petition for writ of *certiorari* should be denied.

Respectfully submitted,

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